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STIENNON & STIENNON

MAY 24 2006

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Pre-Appeal Brief Request for Review

Fax to: **Examiner Nguyen, Tan D.**
U.S. Patent and Trademark Office
Group Art Unit 3629

At Fax No.: **(571) 273-8300**
USPTO central facsimile number

From: Patrick J. G. Stiennon

Date: May 24, 2006

Time: _____

Our Ref.: FORSAL-25

This transmission has 10 pages (including this sheet)



There follows in Application No. 09/966,424.

- PTO/SB/21 Transmittal letter (1 p)
- PTO/SB/17 Fee transmittal form (1 p)
- PTO/SB/31 Notice of Appeal From the
Examiner to the Board of Patent Appeals
and Interferences (1 p)
- PTO/SB/33 Pre-Appeal Brief Request for
Review (1 p)
- Pre-Appeal Brief Request for Review (5 pp)

PTO/SB/21 (12-87)

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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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TRANSMITTAL FORM (To be used for all correspondence after initial filing)		Application Number	09/966,424	
		Filing Date	Sept. 28, 2001	
		First Named Inventor	Kari M. Mak	
		Group Art Unit	3629	
		Examiner Name	Nguyen, Tan D.	
Total Number of Pages in This Submission		Attorney Docket Number	FORSAL-25	
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts Under 37 CFR 1.52 or 1.53		<input type="checkbox"/> Assignment Papers (For an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) And Accompanying Petition <input type="checkbox"/> To Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request for Refund		<input type="checkbox"/> After Allowance Communication To Group <input type="checkbox"/> Appeal Communication to Board Of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Additional Enclosure(s) (Please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 5px;"> <ul style="list-style-type: none"> • Pre-Appeal Brief Request for Review • PTO/SB/33 Pre-Appeal Brief Request for Review </div>
Remarks		The Commissioner is hereby authorized to charge any additional fees that may be required with respect to this communication, or credit any overpayment, to Deposit Account No. 50-2663		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT				
Firm or Individual name		Patrick J. G. Stiennon, Reg. No. 34934		
Signature				
Date		May 24, 2006		
CERTIFICATE OF FACSIMILE TRANSMISSION				
I hereby certify that this correspondence is being facsimile transmitted to United States Patent and Trademark Office on this date:				
				May 24, 2006
Typed or printed name		Patrick J. G. Stiennon, Reg. No. 34934		
Signature				Date May 24, 2006

PTO/SB/17 (12-97)

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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

FEE TRANSMITTAL				Complete If Known																																																																																																																																																																									
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ADDITIONAL FEES <table border="1" style="width:100%; border-collapse: collapse;"> <thead> <tr> <th colspan="2">Large Entity</th> <th colspan="2">Small Entity</th> <th rowspan="2">Fee Description</th> <th rowspan="2">Fee Paid</th> </tr> <tr> <th>Fee Code</th> <th>Fee (\$)</th> <th>Fee Code</th> <th>Fee (\$)</th> </tr> </thead> <tbody> <tr><td>105</td><td>130</td><td>205</td><td>65</td><td>Surcharge - late filing fee or oath</td><td></td></tr> <tr><td>127</td><td>50</td><td>227</td><td>25</td><td>Surcharge - late provisional filing fee or cover sheet</td><td></td></tr> <tr><td>139</td><td>130</td><td>139</td><td>130</td><td>Non-English specification</td><td></td></tr> <tr><td>147</td><td>2,520</td><td>147</td><td>2,520</td><td>For filing a request for reexamination</td><td></td></tr> <tr><td>112</td><td>920*</td><td>112</td><td>920*</td><td>Requesting publication of SIR prior to Examiner action</td><td></td></tr> <tr><td>113</td><td>1,840*</td><td>113</td><td>1,840*</td><td>Requesting publication of SIR after Examiner action</td><td></td></tr> <tr><td>115</td><td>110</td><td>215</td><td>55</td><td>Extension for reply within first month</td><td></td></tr> <tr><td>116</td><td>400</td><td>216</td><td>200</td><td>Extension for reply within second month</td><td></td></tr> <tr><td>117</td><td>920</td><td>217</td><td>460</td><td>Extension for reply within third month</td><td></td></tr> <tr><td>118</td><td>1,440</td><td>218</td><td>720</td><td>Extension for reply within fourth month</td><td></td></tr> <tr><td>128</td><td>1860</td><td>228</td><td>980</td><td>Extension for reply within fifth month</td><td></td></tr> <tr><td>119</td><td>320</td><td>219</td><td>160</td><td>Notice of Appeal</td><td>\$500.00</td></tr> <tr><td>120</td><td>320</td><td>220</td><td>160</td><td>Filing a brief in support of an appeal</td><td></td></tr> <tr><td>121</td><td>280</td><td>221</td><td>140</td><td>Request for oral hearing</td><td></td></tr> <tr><td>138</td><td>1,510</td><td>138</td><td>1,510</td><td>Petition to institute a public use proceeding</td><td></td></tr> <tr><td>140</td><td>110</td><td>240</td><td>55</td><td>Petition to revive - unavoidable</td><td></td></tr> <tr><td>141</td><td>1,280</td><td>241</td><td>640</td><td>Petition to revive - unintentional</td><td></td></tr> <tr><td>142</td><td>1,280</td><td>242</td><td>640</td><td>Utility issue fee (or reissue)</td><td></td></tr> <tr><td>143</td><td>460</td><td>243</td><td>230</td><td>Design issue fee</td><td></td></tr> <tr><td>144</td><td>620</td><td>244</td><td>310</td><td>Plant issue fee</td><td></td></tr> <tr><td>122</td><td>130</td><td>122</td><td>130</td><td>Petitions to the Commissioner</td><td></td></tr> <tr><td>123</td><td>50</td><td>123</td><td>50</td><td>Petitions related to provisional applications</td><td></td></tr> <tr><td>126</td><td>180</td><td>126</td><td>180</td><td>Submission of Information Disclosure Statement</td><td></td></tr> <tr><td>581</td><td>40</td><td>581</td><td>40</td><td>Recording each patent assignment per property (times number of properties)</td><td></td></tr> <tr><td>146</td><td>740</td><td>246</td><td>370</td><td>Filing a submission after final rejection (37 CFR 1.129(a))</td><td></td></tr> <tr><td>149</td><td>740</td><td>249</td><td>370</td><td>For each additional invention to be examined (37 CFR 1.129(b))</td><td></td></tr> </tbody> </table>				Large Entity		Small Entity		Fee Description	Fee Paid	Fee Code	Fee (\$)	Fee Code	Fee (\$)	105	130	205	65	Surcharge - late filing fee or oath		127	50	227	25	Surcharge - late provisional filing fee or cover sheet		139	130	139	130	Non-English specification		147	2,520	147	2,520	For filing a request for reexamination		112	920*	112	920*	Requesting publication of SIR prior to Examiner action		113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action		115	110	215	55	Extension for reply within first month		116	400	216	200	Extension for reply within second month		117	920	217	460	Extension for reply within third month		118	1,440	218	720	Extension for reply within fourth month		128	1860	228	980	Extension for reply within fifth month		119	320	219	160	Notice of Appeal	\$500.00	120	320	220	160	Filing a brief in support of an appeal		121	280	221	140	Request for oral hearing		138	1,510	138	1,510	Petition to institute a public use proceeding		140	110	240	55	Petition to revive - unavoidable		141	1,280	241	640	Petition to revive - unintentional		142	1,280	242	640	Utility issue fee (or reissue)		143	460	243	230	Design issue fee		144	620	244	310	Plant issue fee		122	130	122	130	Petitions to the Commissioner		123	50	123	50	Petitions related to provisional applications		126	180	126	180	Submission of Information Disclosure Statement		581	40	581	40	Recording each patent assignment per property (times number of properties)		146	740	246	370	Filing a submission after final rejection (37 CFR 1.129(a))		149	740	249	370	For each additional invention to be examined (37 CFR 1.129(b))	
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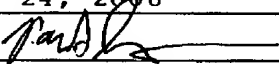
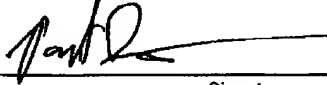
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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) FORSAL-25	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" (37 CFR 1.8(a)) on <u>May 24, 2006</u> Signature <u></u> Typed or printed name <u>Patrick J.G. Stiennon</u>		Application Number 09/966,424	Filed Sept. 28, 2001
		First Named Inventor Kari M. Mäki	
		Art Unit 3629	Examiner Nguyen, Tan. D.
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 34934 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature Patrick J.G. Stiennon Typed or printed name 608-250-4810 Telephone number May 24, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			


This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PAGE 06
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Applicant: Kari M. Mäki Date: May 24, 2006
Date Filed: Sept. 28, 2001 Docket No.: FORSAL-25
App. No.: 09/966,424 Art Unit: 3629
For: Maintenance Management System Examiner: Nguyen, Tan D.
for a Production Plant

<p align="center">Certificate of Facsimile Transmission</p> <p align="center">I hereby certify that this correspondence is being transmitted via facsimile to the U.S. Patent and Trademark Office</p> <p align="center">on <u>May 24, 2006</u> Date</p> <p align="center"> Signature</p> <p align="center"><u>Patrick J. G. Stiennon, Reg. No. 34934</u> Name of applicant, assignee or Registered Representative</p>

Pre-Appeal Brief Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

ARGUMENT

The examiner has failed to consider all the limitations of the claims in making his rejection.

A. The examiner has failed to consider the preamble a positive limitation on the claims.

In the Office action dated Feb. 24, 2006, on p. 3, lines 11-14, and p. 16, lines 9-14, the examiner states:

Moreover, this limitation [to a paper mill, or board mill or pulp production plant or paper finishing plant] only appears in the preamble and [is] not shown in the body of the claim and therefore, it receives very little patentable weight. If this limitation is critical, it should also appear in the body of the claim.

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The claims are limited to a paper mill, or board mill or pulp production plant or paper finishing plant, which is a positive limitation in all the claims because: 1. Applicant has stated on the record that the preamble breathes life and breath into the claims (Amendment Filed Dec. 5, 2005, p. 9, lines 12–15) (see MPEP 2111.02, p. 2100-52, col. 2, lines 31–35); 2. The body of each claim refers to the preamble “production plant” thus making the preamble a positive limitation of the claims; and 3. A paper mill, or board mill or pulp production plant or paper finishing plant have been explicitly set forth as a limitation in the body of claims 20 (twice) and 21 (four times).

EP 0 822 473 discloses at Col. 1, lines 6–8: “Maintenance against a trouble in an industrial equipment requiring maintenance, such as a semiconductor device manufacturing apparatus”, but not the claimed “paper mill, or board mill or pulp production plant or paper finishing plant”. *EP 0 822 473* discloses generic industrial equipment “such as a semiconductor device manufacturing apparatus”, but that only makes it obvious to try the method disclosed on various manufacturing apparatus but does not make obvious by itself a method for servicing a paper mill, a board mill, a pulp production plant, or a paper finishing plant. But more to the point, *EP 0 822 473* teaches performing or managing maintenance on industrial equipment of various types, while applicant’s claims are directed to performing additional functional steps with respect to production systems of a paper mill, a board mill, a pulp production plant, or a paper finishing plant.

B. Limitations in the body of the claims not considered by the examiner

Claim 20

**a production management system holding specifications of
ordered products and passing information to the process
control system;**

Ordered products as they relate to the claimed system is not addressed by the examiner.

**receiving in a reporting system, data from the process
control system, the production management system, the**

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maintenance information system, and the machinery conditioning system, and processing said data into different types of formatted reports;

Processing data into formatted reports is not addressed by the examiner.

scheduling maintenance periods based on the continuous data collection and extending the periods when the units of machinery exhibit continuous operation without any signs of malfunction;

Extending periods of continuous operation is not addressed by the examiner.

Claim 21

continuously gathering data related to manufacturing processes and machinery of the paper mill, or the board mill, or the pulp production plant, or the paper finishing plant by a plurality of information systems comprised of a process control system, a production management system, a maintenance information system, and a machinery condition monitoring system;

The specific control system with four components is not addressed by the examiner.

utilizing a process control system to receive selected target values of variables relating to the production of pulp, paper, board, or paper finishing, and to gather measurement data from process machinery of the paper mill, board mill, pulp production plant or paper finishing plant, and to control said process machinery;

Gathering measurement data of a particular type and control of a particular type of process machinery is not addressed by the examiner.

utilizing a production management system to hold specifications of ordered products and to pass information to the process control system;

Specifications of ordered products and the process steps connected therewith are not addressed by the examiner.

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utilizing a machinery condition monitoring system to log process parameters including vibrations, circulating lubrication oil system, bearings, and cleanliness of fabrics;

Logging vibrations, oil systems, bearings and fabrics are not addressed by the examiner.

receiving in a reporting system data from the process control system, the production management system, the maintenance information system, and the machinery conditioning system, and processing said data into different types of formatted reports;

Formatting reports is not addressed by the examiner.

The examiner has not considered these limitations which highlight the differences between *EP 0 822 473* and applicant's claimed invention "a paper mill, or board mill or pulp production plant or paper finishing plant". The reference point of *EP 0 822 473* is semiconductor device manufacturing which does not suggest applicant's claimed steps which relate to, are informed by, and which claim a method for servicing a paper mill, a board mill, a pulp production plant, or a paper finishing plant.

The standard for a prima facie case of obviousness is set forth at MPEP 706.02 (j) "The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done." If the references do not expressly or impliedly suggest the claimed invention then "the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

Continuing to refer to MPEP 706.02 (j) "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

The examiner has, instead of making a prima facie case, argued the references do not specifically exclude applicant's claimed steps, repeatedly referring to open ended language of the *EP 0822 473* specification, (see Office Action dated Feb. 24, 2006, p. 4, lines 13-17; p. 9,

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lines 10–13; p. 10, lines 12–14, and p. 17, lines 1–6). Finally, the examiner explicitly shifts the burden of making a prima facie case on to the applicant stating “Therefore, applicants have not shown why it’s not obvious to apply the teaching [of] EP 0822 473 to other industries.” (P. 17, lines 5–6.)

With respect to claim 19, the examiner has failed to consider the preamble as a positive limitation, and with respect to the limitation contained in the preamble has not shown a motivation and expectation of success in applying the teaching of *EP 0822 473* to a paper mill, a board mill, a pulp production plant, or a paper finishing plant. Further with respect to claims 20, and 21 the examiner has additionally failing to make a prima facie case of obviousness for each element of each claim and thus has failed to make his prima facie case with respect to claims 20, and 21.

Allowance of all pending claims is respectfully requested.

Respectfully submitted,



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